

"The stand of Wheeler [sic, Petterson] holds the dispensing section generally at an oblique angle to the horizontal, this angled presentation reduces the pressure in the stack and aids in presentation by having the opening of the dispenser at an oblique angle to the horizontal. Though the disclosure of Petterson is silent to these advantages they are obvious to one skilled in the art."

The Examiner's Answer provides no basis for its contention that the Petterson stand positions the body at an oblique angle to the horizontal ("generally" or otherwise), because of course it simply doesn't. The body of Petterson is instead continuously curved along a radius of curvature that corresponds to the particular type of napkin stack that Petterson is designed to dispense. It is this continuous curvature of the Petterson housing that is said at column 4, lines 22-40 to be responsible for the advantages actually disclosed by the reference.

Appellants therefore respectfully disagree with the ensuing contention in the passage of the Examiner's Answer quoted above that the admittedly undisclosed advantages of the non-existent Petterson disclosure are (or would have been) obvious to one skilled in the art.

The Examiner's Answer next addresses Wheeler, and attempts to respond to the point made in Appellants' brief that Wheeler does not have a straight upstream section that extends over the majority of the length of

its body, as called for present claim 1, by contending that

“Wheeler's cabinet...includes an upstream section of the dispenser including the three subsections comprised of two straight and a small curved section defining the majority of the length.”

Collectively, then, the three “subsections” of Wheeler are straight in the sense that the letter U is straight, which is to say that they are not straight. It is difficult to see how the passage quoted above is other than a concession of the case as to this ground of rejection.

The Examiner's Answer next seeks to provide an improved rationale for the proposed combination of Petterson and Wheeler, arguing that a skilled artisan would choose the Petterson stand for the Wheeler dispenser because Petterson discloses a stand “designed to help reduce stack pressure.” As noted above, however, and as conceded in the Examiner's Answer, no such teaching actually exists in Petterson, and the reference is on the contrary explicit that it is the continuously curved housing that provides the advantages identified by Petterson. Moreover, as Wheeler is a wall-mounted dispenser, it is not apparent why one skilled in the art would be choosing a stand in the first place, and the Examiner's Answer offers nothing to clear up that mystery.

The Examiner's Answer concludes its defense of the proposed combination of Wheeler and Petterson by noting that, although Wheeler is admittedly a very tall cabinet it would still be physically possible to mount it at an oblique angle on a stand provided that the angle were very steep and the footprint of the stand were considerably larger. The Examiner's Answer however is silent as to the fact that those admittedly necessary modifications would negate any benefit of having a stand mount in the first place.

The Examiner's Answer also seems untroubled that its analysis of Petterson is directly contrary to the findings of fact made by the Board in the previous appeal no. 2007-3501. See, for example, page 5, lines 2-13 of the previous Board decision, where the Board found as follows:

The napkins as described by Petterson are thicker along the folded edge than along the opposite edge due to the nature of the fold. (Petterson, col. 3, ll. 34-37). The uneven thickness of the napkins causes stacks of such napkins to bend with predetermined radii of curvature. (Petterson, col. 3, ll. 39-47). The back wall of the housing of Petterson's apparatus is smoothly curved with a radius of curvature generally corresponding to the predetermined curvature of a stack of the napkins. (Petterson, col. 3, ll. 54-57). Petterson teaches that the curved housing is an improvement over a straight, vertical housing in that "a greater number of paper napkins can be stacked within a specified vertical distance than would be the case if the housing was essentially

straight and perpendicular." (Petterson, col. 4, ll. 41-45).

The rationale for the proposed combination of Wheeler and Petterson, as with the other rejections on appeal, is also fundamentally at odds with the Board's reasoning in its decision of June 25, 2008. See page 6, lines 2-5 of that decision:

Substitution of a straight upstream section for the curved housing of Petterson's dispensing apparatus would be contrary to Petterson's teaching that the curved housing is an improvement over a straight, vertical housing such as that shown in Swift.

As to the proposed combinations of Breger and Petterson and Hubanks and Petterson, the Examiner's Answer urges affirmance for the same reasons given for the Wheeler and Petterson combination.

As to the import of the prior Board decision, the Examiner's Answer at pp. 8-9 argues that so long as different prior art is used to reject the same claims that were previously before the Board (albeit art that was itself previously of record), then the findings and analysis of the Board in its prior decision are of no effect. That position does not comport with Appellants' understanding of the respective roles and authority of the Board and the examining corps.

As to the wilful and continuing violation of Rule 198 that necessitated the present appeal, the

Examiner's Answer at page 9 makes the remarkable declaration that "the issue is moot" because Appellants did not petition to compel compliance with the rule and because Appellants were allegedly "offered the choice to receive a supplemental rejection."

As to the alleged offer of a "supplemental rejection," none was made during the interview conducted on October 23, 2008, and the Examiner Interview Summary Record (copy attached) makes no reference to any such offer.¹ It is furthermore unclear how the examiners in attendance at that interview would have been in a position to "offer" the written approval of the Director of the United States Patent and Trademark Office before such approval had even been sought.

More fundamentally, Rule 198 appears to be intended to ensure that the Board's decisions are respected as the law of the case, and to prevent reopening of prosecution absent clear justification. Indeed, it is striking that the Examiner's Answer still reveals no awareness of, much less approval by, the Director of the extraordinary actions taken in this case following the Board's decision of June 25, 2008.

¹ Indeed, the undersigned, despite some years of practice before the Office, is uncertain just what a "supplemental rejection" is, having never received one.

Compliance with that rule is not seen to be optional absent action by an applicant to compel compliance; neither could an applicant somehow waive the rule even if it wished to do so. However, as the rule in question concerns internal procedures within the Office and the respective roles of the Board and the examining corps, it is ultimately not for appellants to determine whether the examining corps can unilaterally declare the rule to be moot.

As discussed above and in appellants' main brief, it is believed to be clear that the rejections on appeal are improper and should be reversed, independently of the continuing and admitted violation of Rule 198. However, the remarkable procedural posture of this case raises further serious questions as to the propriety of the rejections on appeal.

Respectfully submitted,

YOUNG & THOMPSON

By 

Andrew J. Patch
Attorney for Appellants
Registration No. 32,925
209 Madison Street, Ste 500
Alexandria, VA 22314

Telephone: 703/521-2297

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APPENDIX:

Examiner's Interview Summary

<i>Interview Summary</i>	Application No. 10/660,659	Applicant(s) HOCHTRITT ET AL.	
	Examiner TIMOTHY R. WAGGONER	Art Unit 3651	

All participants (applicant, applicant's representative, PTO personnel):

(1) TIMOTHY R. WAGGONER. (3) ANDREW J. PATCH.

(2) GENE CRAWFORD. (4) _____.

Date of Interview: 10/23/2008.

Type: a) ☐ Telephonic b) ☐ Video Conference
c) ☒ Personal [copy given to: 1) ☐ applicant 2) ☒ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☐ No.
If Yes, brief description: _____.

Claim(s) discussed: 1.

Identification of prior art discussed: Petterson/Wheeler.

Agreement with respect to the claims f) ☐ was reached. g) ☒ was not reached. h) ☐ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: Discussed the merits and procdure of the non-final rejection in light of the board decision.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN A NON-EXTENDABLE PERIOD OF THE LONGER OF ONE MONTH OR THIRTY DAYS FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WHICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.